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09/372,416	08/11/1999	JONATHAN DORFMAN	EWG-087	1373

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BEH Investments LLC
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EXAMINER

HUYNH, THU V

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/372,416

Applicant(s)

DORFMAN, JONATHAN

Examiner

Thu V. Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This action is responsive to communications: RCE and amendment filed on 08/05/2005 to application filed on 08/11/1999.
2. Claims 1, 4-6, 10, 14, 16-17 are amended.
3. Claims 1-17 are pending in the case. Claims 1, 4-6, 10 and 16-17 are independent claims.
4. Previous rejections have been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Burman et al., US 2001/0010059 A1, filed 10/1998.**

Regarding independent claim 1, Burman teaches the steps of:

- a web browser which can retrieve files, interpret JavaScript, and display web pages (Burman, [0046]-[0047]; a web browser can retrieve web pages, run JavaScript and displaying the web page), a first internet server which includes a web page that includes a macro tag (Burman, fig.1, [0047]-[0062], [0142]-[0143], the web page includes a macro tag to request a rich media, such as JavaScript file, wherein the web page is located on server 46), a second internet server which includes a JavaScript file

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(Burman, fig. 1, [0047], the rich media (JavaScript file) is located on media server 38);

- an advertisement server which provides advertisements in response to links from said browser (Burman, fig. 1, [0066]-[0069], advertisement image requested by the web browser is located on advertisement selection server 32);
- said macro tag including a link to said second internet server (Burman, [0047]-[0062], the macro tag including a link to media server which stores rich media (JavaScript file)); and
- said JavaScript file including a static link to said advertisement server, whereby said JavaScript file is executed and an advertisement is displayed each time said browser accesses said web page (Burman, fig. 1, [0047], [0063]-[0069]; JavaScript files [0136]-[0137], [0140]-[0146]; the rich media (JavaScript file) includes a static link to advertisement selection server 32, whereby said rich media is executed causing the web browser requests and displays advertisement image each time the browser access the web page).

Regarding dependent claim 2, which is dependent on claim 1, Burman teaches wherein said macro tag has commands to access said advertisement server if said web browser does not have the capability of executing JavaScript (Burman, [0048]-[0063], when browser does not support script, “noscript” element provide a hypertext link to advertisement selection server 32).

Regarding dependent claim 3, which is dependent on claim 1, Burman teaches wherein said web page contains HTML code (Burman, [0047], the request web page in HTML format “webPage1.html”).

Regarding independent claim 4, Burman teaches a method linking to an advertisement server from a web page, including on said web page a macro tag with a link to a file (Burman, [0047]-[0062], user requests a web page. The web page includes a macro tag to request a rich media file), said file including JavaScript commands, which include a static link to said advertisement server, whereby advertisements called for by said macro tag are displayed (Burman, fig. 1, [0047], [0063]-[0069]; JavaScript files [0136]-[0137], [0138]-[0146]; the rich media is a JavaScript file which includes a static link to advertisement selection server 32, whereby said rich media is executed causing the web browser requests and displays advertisement image).

Regarding independent claim 5, Burman teaches a system includes browsers which access web pages (Burman, figures 1-2, [046]-[0047]; users' browsers request web pages), comprising a command file with a static link to a specific advertisement server (Burman, [0066]-[0069], JavaScript files in [0136]-[0137], [0138]-[0146], rich media file, such as JavaScript, includes a static link to specific advertisement selection server 32), said web pages including macro tags which direct said browsers to retrieve said command file (Burman, [0047]-[0062], the web pages include macro tags which direct the users' browsers to retrieve the rich media files (JavaScript files)), whereby said browsers are directed to retrieve advertisements

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from said advertisement server when they access one of said web pages (Burman, [0047]-[0063], [0066]-[0070]; the users' browsers retrieve advertisements from advertisement selection server 32 for displaying when the browser access the web pages).

Regarding independent claim 6, Burman teaches a system for displaying an advertisement on a user's computer in response to commands in a macro tag on a web page which is accessed by an internet browser on said user's computer (Burman, [0047]-[0063], [0066]-[0070]), said system comprising:

- a first server with a file that contains a series of commands that can be executed by said browser (Burman, fig. 1, [0047], [0066]-[0068], rich media (JavaScript file) stored in media server 38. The rich media contains commands that can be executed by the browser);
- a second server that contains said advertisement (Burman, fig. 1, [0066]-[0069], advertisement selection server 32 provides advertisement image);
- a link to said file in said macro tag (Burman, [0047]-[0063], rich media request includes a link or reference to the rich media (JavaScript file));
- a static link to said second server in said file (Burman, [0063], [0066]-[0070], JavaScript files in [0136]-[0146], the rich media (JavaScript file) includes a static link to advertisement selection server 32 for selecting advertisement image); and
- whereby when said macro tag is executed by said browser, said file is retrieved and said static link in said file is executed to retrieve said advertisement and to display said advertisement on said user's computer (Burman, [0047]-[0063], [0066]-[0070];

the browser send a rich media request, the rich media (JavaScript file) is retrieved and the JavaScript file which includes a static link to advertisement selection server 32 for selecting and displaying the advertisement image from the advertisement selection server 32 when the browser access the web page).

Regarding dependent claim 7, which is dependent on claim 6, Burman teaches wherein said file contains JavaScript commands (Burman, [0047], the rich media is a JavaScript file).

Regarding dependent claim 8, which is dependent on claim 6, Burman teaches wherein said advertisement is a gif-image or Java applet (Burman, [0012], [0146], "gif" image file).

Regarding dependent claim 9, which is dependent on claim 6, Burman teaches wherein said file contains JavaScript (Burman, [0047], the rich media is a JavaScript file).

Regarding independent claim 10, Burman teaches a system where users access web pages using a browser, a web page that includes a macro tag with a reference to a file on a first server, whereby said browser links to said file when said web page is processed by said browser, said file including a static link to a specific advertisement server having an advertisement in a file, whereby said advertisement is displayed by said browser when said file is processed by said browser (Burman, [0047]-[0063], [0066]-[0070], JavaScript files in [0136]-[0137], [0138]-[0146], user request a web pages using a browser. A web page that includes a macro tag with reference to a rich media (JavaScript file) on server 47, said browser retrieve the rich media

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(JavaScript file) when the web page is requested by the browser, the rich media (JavaScript file) including a link to advertisement selection server 37 having advertisement image, whereby said rich media (JavaScript file) is executed causing the advertisement image is displayed)

Regarding dependent claim 11, which is dependent on claim 10, Burman teaches wherein said file contains JavaScript (Burman, [0047], the rich media is JavaScript format).

Regarding dependent claim 12, which is dependent on claim 10, Burman teaches wherein said macro tag contains a series of HTML statements (Burman, [0028]-[0062]).

Regarding dependent claim 13, which is dependent on claim 11, Burman teaches wherein said macro tag contains a series of HTML statements (Burman, [0028]-[0062]).

Regarding dependent claim 14, which is dependent on claim 11, Burman teaches wherein said macro tag includes a link to said advertisement server which is executed if said browser cannot execute JavaScript (Burman, [0048]-[0063], when browser does not support script, “noscript” element provide a hypertext link to advertisement selection server 32).

Regarding dependent claim 15, which is dependent on claim 11, Burman teaches wherein said system determines the characteristics of said browser and executes instruction compatible with said browser’s characteristics to display said advertisement (Burman, [0048]-[0062], [0136]-[0146], displaying advertisements depend on different user computer browsing

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platforms, such as “browsers that can render/execute and “IFRAME” tag” and “browsers that CANOT render/execute the “IFRAME” tag, but can interpret/execute JavaScript”).

Regarding independent claim 16, Burman teaches a system for displaying advertisements comprising the steps of:

- a web browser which can retrieve files, parse HTML code and display web pages (Burman, [0047]; a web browser can retrieve web pages, parse HTML code to retrieve JavaScript files in a web page and displaying the web page through the web browser);
- an advertisement server for providing advertising content (Burman, fig.1, [0066]-[0069], advertisement selection server 32 provides advertisement image);
- a JavaScript file which includes a static reference to said advertisement server and commands for requesting the advertisement content from the advertisement (Burman, [0047]-[0063], [0066]-[0069], JavaScript files [0136]-[0137], [0140]-[0146]; a JavaScript file which includes a static reference to advertisement selection server 32 and JavaScript commands for selecting the advertisement image from the advertisement selection server 32);
- a web page server which includes a web page that includes a macro tag, the tag including a reference to the JavaScript file (Burman, [0047]-[0063], a web page includes a macro tag for request the JavaScript file, wherein the web page is located on server 46); and

- whereby, the advertising content is displayed when the browser access the web page (Burman, [0047]-[0063], [0066]-[0070], the advertisement image is displayed when the browser access the web page).

Regarding independent claim 17, Burman teaches a method for referencing to an advertisement server from a web page, the method comprising the steps of:

- including in the web page a reference to a file (Burman, [0047]-[0062], user requests a web page. The web page includes a reference to a rich media file, such as JavaScript file); and
- including in the file a static reference to an advertisement server and JavaScript commands for requesting the advertisement from the advertisement server (Burman, fig. 1, [0063]-[0069]; JavaScript files [0136]-[0137], [0140]-[0146]; the rich media (JavaScript file) includes a static reference to advertisement selection server 32, causing the advertisement selection server 32 select an advertisement image).

Response to Arguments

7. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Applicants point out that “the pending claims now reflects either a “static link” or “static reference” to the advertisement server”.

However, Burman teaches such limitations as explained in the rejection above.

Conclusion

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8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Newman et al., US 6,085,229, filed 05/1998, teaches method for providing client side personalization of content of web pages.

Schwerdtfeger et al., US 6,725,424 B1, filed 12/1999, teaches electronic document delivery system employing distributed document object model based transcoding and providing assistive technology support.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is (571) 272-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TVH
August 19, 2005

William S. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
8/21/2005